

REMARKS/ARGUMENTS

Claims 1-5, 7-20 and 22-23 are pending in the application. Claims 1-23 have been rejected. Claims 6, 13 and 21 have been canceled. Claims 1, 7, 8, 14, 16, and 22 have been amended. Applicants respectfully request reconsideration in view of the amendments and the following remarks/arguments.

Rejections under 35 U.S.C. §101.

The Office Action rejected claims 1-23 as being directed to non-statutory subject matter. Section 101 of the Patent Statute provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." Excluded from patent protection are laws of nature, physical phenomena, and abstract ideas. Parker v. Flook, 437 U.S. 584, 198 USPQ 193 (1978). Claim 1 and its dependent claims 2-5 and 7 are directed to the process or method category of patentable subject matter. Claim 8 and its dependent claims 9-12 and 14-15 are directed to the machine category; and claim 16 and its dependent claims 17-20 and 22-23 are directed to the manufacture category. The Office Action does not show that the claimed subject matter falls within any of the judicial exceptions to patentability. Therefore, the claims are indeed directed to patentable subject matter.

Rejections under 35 U.S.C. §112.

Claims 1-23 have been rejected for not complying with the enablement requirement. The PTO cannot make this type of rejection, however, unless it has reason to doubt the objective truth of the statements contained in the written description. See In re Brana, 51 F.3d 1560, 1564 n.12, 34 USPQ2d 1436, 1439 n.12 (Fed. Cir. 1995) ("[T]he PTO has the initial burden of challenging a presumptively correct assertion of utility in the disclosure. Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility.") (citations omitted); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971) ("[A] specification disclosure which contains a teaching of

the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support."). Applicant submits that this rejection is erroneously based on the mistaken belief that the claims are not directed to patentable subject matter and must thus be withdrawn.

The Office Action argues that the specification does not provide a clear and concise description of the process for mapping and the conversion. To the contrary, the specification contains various working embodiments (see FIG. 3 and its description, for example). The Office Action has not shown any reason to doubt the truth of any statement in the disclosure and therefore this rejection should be withdrawn.

Claims 1-23 were also rejected as being indefinite. With respect to claim 1 the Office Action contends that it is unclear whether names of the XML schema are employed. Claim 1 clearly states that components of the conversion language are based on the names of the XML schema components. Because claim 1 is not believed to be indefinite the other claims have not been shown to be indefinite.

Rejections under 35 U.S.C. §102.

The Office Action has rejected claims 1-5, 9, and 16 under 35 U.S.C. §102 as being anticipated by United States Patent No. 6,569,207 issued to Sundaresan (hereafter, "Sundaresan") and claims 1-5, 8-12, 15-20 and 23 as anticipated by Jain (Pub. No. 2002/0073091). Claims 1, 8, and 16 have been amended to include the limitations of claims 6, 13, and 21, respectively. Because the Office Action found that the allegedly anticipating prior art (Sundaresan and Jain) did not disclose the limitations of claims 6, 13, and 21 the anticipation rejection is overcome for independent claims 1, 8, and 16. Claims 2-5 are dependent on claim 1, claim 9 is dependent on independent claim 8, and are not anticipated for the reason that their respective parent claims are not anticipated.

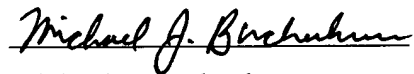
Rejections under 35 U.S.C. §103.

The Office Action rejected claims 6, 7, 13, 14, 21, and 22 as unpatentable over

Jain (20020073091) in view of Bent (2002/0026471). Section 103(c)(1) provides "Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." The subject matter claimed by the instant application was under an obligation of assignment to International Business Machines Corporation (IBM) at the time the claimed invention was made. U. S. Patent No. 6,569,207 and the Bent patent application (2002/0026471) were both owned by IBM at that time. Therefore, neither U. S. Patent No. 6,569,207 nor publication 2002//0026471 shall preclude the patentability of the claimed subject matter.

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims and that a timely Notice of Allowance be issued in this case.

Respectfully submitted,




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I hereby certify that this Amendment and Response to Office Action is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on this the 5th of September 2006.


Michael J. Buchenhorner

Date: September 5, 2006

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